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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,613	10/03/2003	Jamie Garroch	NEC P15578	9435

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EXAMINER	
SANTIAGO CORDERO, MARIVELISSE	
ART UNIT	**PAPER NUMBER**
2687	

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/678,613	GARROCH, JAMIE	
	Examiner	Art Unit	
	Marivelisse Santiago-Cordero	2687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,8 and 9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,8 and 9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 September 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-5 and 8-9 are pending. Claims 6-7 were cancelled.

Response to Arguments

2. Applicant's arguments with respect to claims 1-5 and 8-9 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. Claims 1-5 and 8-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, the limitation "a selection bar on the display by which a user also may select a highlighted function" was not described in the specification. The specification does disclose a selection bar to indicate which function is presently highlighted and available for selection (page 4, lines 15-17); a highlighted function indicated on a selection bar on the screen (Fig. 3; page 5, lines 4-6). However, the Examiner did not find support for the limitation "a selection bar on the display **by which a user also may select a highlighted function**". It is noted that the support for the selection bar on the display is based on an indication of a presently highlighted and available for selection function, but does not support the specific limitation of "by which the user also may select" a highlighted function.

Therefore, for purposes of examination, the limitation "a selection bar on the display by which a user also may select a highlighted function" is being interpreted as a selection bar to

indicate which function is presently highlighted and available for selection as disclosed and supported by the specification.

The Applicant is welcomed to point out where in the specification the examiner can find support for this limitation, if Applicant believes otherwise.

Claim Objections

4. Claims 1-5 and 8-9 are objected to because of the following informalities: the term "an user" (claim 1, lines 3 and 4) should be replaced with --a user--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk (GB 2344905; cited in IDS) in view of Karkkainen et al. (hereinafter "Karkkainen"; Patent No.: 6,600,936).

Regarding claim 1, Kirk discloses a portable electronic device (Abstract; Figs. 1) comprising a display on a front face of the device (Abstract) on which selectable functions may be displayed (Abstract; note the application icons; Fig. 1), and selected by a user (Abstract), a selection button by which the user may confirm selection of a function (Abstract; Fig. 1, reference numeral 5; page 4, lines 8-12), and a touch pad provided on a rear face of the device for a user to select the functions (Abstract; Fig. 2, reference numeral 4).

Kirk fails to disclose selectable functions may be highlighted, confirming selection of a **highlighted** function, and a selection bar on the display by which a user also may select a highlighted function.

However, Karkkainen discloses a portable electronic device comprising a display on a front face of the device (Fig. 1) on which selectable functions may be displayed (Fig. 1), highlighted (col. 2, lines 30-36), and selected (col. 2, lines 30-36), a selections button by which a user may confirm selection of a highlighted function (Fig. 1, reference numeral 5; col. 5, lines 10-11); and a selection bar on the display by which a user also may select a highlighted function (Figs. 5-7, reference F).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to incorporate in the display of Kirk a selection bar by which a user also may select a highlighted function as suggested by Karkkainen.

One of ordinary skill in this art would have been motivated to incorporate in the display of Kirk a selection bar by which a user also may select a highlighted function because additional information is provided for a user, in case he/she does not know the meaning of icons very well

and to enable a quicker understanding of the selected menu items (Karkkainen: col. 3, lines 57-62).

Regarding claim 2, in the obvious combination, Kirk discloses in which the touch pad is positioned substantially directly behind the display (Fig. 2; page 3, lines 16-18).

Regarding claim 3, in the obvious combination, Kirk discloses in which a cursor is presented on the display and is controlled by the user using the touch pad (Fig. 1, reference C; page 3, lines 22-27).

Regarding claim 4, in the obvious combination, Karkkainen discloses in which the function which is available for selection is highlighted (col. 2, lines 30-36).

Regarding claim 5, in the obvious combination, Kirk discloses in which the touch pad has the same dimensions as the display (page 3, lines 16-18).

Regarding claim 8, in the obvious combination, Kirk discloses further including a software controlled circuitry which translates a point of contact on the touch pad to a corresponding portion on the display (page 5, line 24 through page 6, line 7).

7. Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk in combination with Karkkainen as applied to claim 1 above, and further in view of Chia-Ying et al. (hereinafter "Chia-Ying"; Patent No.: 5,717,431).

Regarding claim 9, Kirk in combination with Karkkainen fails to disclose in which the selection button also allows a user to execute 'click' and 'drag-lock' operations.

However, Chia-Ying discloses a portable electronic device in which a selection button also allows a user to execute 'click' and 'drag-lock' operations (col. 6, lines 49-57).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to execute in the selection button of Kirk in combination with Karkkainen 'click' and 'drag-lock' operations as suggested by Chia-Ying.

One of ordinary skill in this art would have been motivated to execute in the selection button of Kirk in combination with Karkkainen 'click' and 'drag-lock' operations because it would allow the user to arrange and/or sort the selection based on user's preferences.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marivelisse Santiago-Cordero whose telephone number is (571) 272-7839. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SONNY TRINH
PRIMARY EXAMINER